



PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

0095-194

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on August 8, 2006 ✓Signature Michael H. Jester ✓Printed Name Michael H. Jester ✓

Application Number

09/846,994

Filed

May 1, 2001

First Named Inventor

Richard E. Hunter

Art Unit

3752

Examiner

Davis D. Hwe

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheets(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

Michael H. Jester ✓
Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

Michael H. Jester
Typed or Printed Name

☐ (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 28,022

619/628-4598
Telephone Number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

August 8, 2006 ✓
Date

NOTE: signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. the information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES**

In re Patent Application of:)	
)	
Richard E. Hunter et al.)	Examiner: Davis D. Hwe
)	
Serial No.: 09/846,994)	Group Art Unit: 3752
)	
Filed: May 1, 2001)	Confirmation No.: 3915
)	
For: <i>Rotor-Type Sprinkler with</i>)	
<i>Turbine Over-Spin Prevention</i>)	

**REASONS IN SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

BOARD OF PATENT APPEALS & INTERFERENCES
Director for Patents and Trademarks
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the final Office Action mailed June 14, 2006, please reconsider the patentability of the pending claims in light of the following remarks.

The subject patent application has now been pending for more than five (5) years. Accordingly, this application, including all proceedings before the examiner and all appellate proceedings within the USPTO, are to be handled on an expedited basis because the case is effectively a *special* status case. The MPEP §707.02 and MPEP §708.01(I). Claim 1 has been rejected for obviousness over U.S. Patent No. 5,375,768 of Clark. In the Rule 132 Declaration which was submitted, Michael L. Clark, the inventor of the cited '768 patent, states that the sprinkler disclosed in said '768 patent does not include a valve as called for in Claim 1, as previously amended.

Assuming, for the sake of argument, that the examiner intended to reject Claim 1 as amended for anticipation over the '768 Clark patent, the examiner is ignoring the Rule 132 Declaration of Michael L. Clark in which he states, under oath, that the sprinkler disclosed in the '768 Clark patent "does not include a valve that prevents, by selectively re-directing the pressurized fluid around the turbine, over-spinning of the turbine when the pressurized fluid is air, or a mixture of water and air." (See paragraph 8, declaration of Clark executed April 12, 2006). The examiner's statement, on page 3 of the June 14, 2006 Office Action, that the valve 62 of the '768 Clark patent is "fully capable of carrying out the same function regardless of whether the fluid is water, air or a combination of both" is fully rebutted by the Michael L. Clark declaration previously filed. The examiner concedes, in the latest Office Action, that the sprinkler of the '768 Clark patent is disclosed as only operating with water, and not air or a mixture of water and air.

In the latest Office Action of June 14, 2006, the examiner states that obviousness rejection based on the '768 Clark patent does not require any modification of the sprinkler disclosed in that patent. The examiner has not rejected Claim 1 for anticipation over the '768 Clark patent. Accordingly, the rejection is fundamentally flawed. If the rejection is truly an obviousness rejection, then the examiner must state what modifications are necessary to the sprinkler disclosed in the '768 Clark patent and what teaching, suggestion or motivation existed at the time Applicants' invention was made to make such modifications.

Making the assessment of the differences between the prior art and the claimed subject matter under Section 103 specifically requires consideration of the claimed invention "as a whole." *Ruiz v. A.B.Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004). Inventions are typically new combinations of existing principles or features. *Envtl. Designs Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983). Thus the "as a whole" requirement of Section 103 is very important, otherwise an obviousness assessment might simply break a claimed invention into its component parts, and then find the individual components in the prior art. Such an assessment, using the inventor's claim as a road map, amounts to impermissible hindsight reconstruction. This improper method of determining obviousness would discount the value of combining various existing features or

principles in a new way to achieve a new and useful result - which is often the essence of valuable innovation.

To guard against hindsight reconstruction, in order to establish a *prima facie* case of obviousness during *ex parte* examination of a patent application pending in the USPTO, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Accordingly, withdrawal of the obviousness rejection of Claim 1 as previously amended over the '768 Clark patent is requested.

A Form PTO-SB-33 and Notice of Appeal are being filed concurrently herewith.

A check in the amount of \$500 is enclosed to cover the Brief fee. Please charge any deficit or credit any excess to my Deposit Account No. 50-0626.

Respectfully submitted,

 8/8/06

By: Michael H. Jester
Attorney for Applicants
Registration No. 28,022